

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yakov KAMEN et al.

Serial No.: 10/008,229

Filed: November 30, 2001

For: Method and System for Content
Based Broadcasted Program
Selection

Atty. Docket No.: 007287.00015

Group Art Unit: 2623

Examiner: Usha Raman

Confirmation No.: 6955

REPLY BRIEF

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Sir:

This *Reply Brief* is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed October 28, 2010. Because Appellants believe that the examining corps' errors are readily ascertainable on the briefs, Appellants do not request an oral hearing at this time. However, if the Board of Patent Appeals & Interferences believes that an oral hearing would be beneficial, the Board is invited to contact Appellants' undersigned representative at (202) 824-3174.

Remarks

The Examiner's Answer at pp. 3-14 repeats the rejections in the final Office Action dated March 2, 2010, which were fully addressed in Appellants' Appeal Brief filed June 2, 2010. This Reply Brief addresses the Answer's "Response to Argument" beginning on page 15.

I. *Claims 7-12 are directed to statutory subject matter..*

The Examiner's Answer asserts that tangible can describe a non-physical state and cites to the Third College Edition of Webster's New World Dictionary of American English definition of tangible, which recites "that can be understood; definite; objective," for support. *See* Examiner's Answer at p. 15. Appellants respectfully disagree. Even considering this definition, there is no support for tangible being directed to non-physical states, as supported by definitions from the Random House Dictionary, Collins English Dictionary – Complete & Unabridged 10th Edition, Online Etymology Dictionary, and Merriam-Webster's Dictionary of Law, which define tangible as "capable of being touched." Accordingly, Appellants submit that electrical, optical, acoustical and other forms of propagated signals do not constitute "tangible computer-readable media" as recited in claim 7 and thus, that claim 7 does recite patentable subject matter.

Claims 8-12 depend from claim 7 and are allowable for at least the same reasons as claim 7.

II. *Claim 21 does comply with the written description requirement.*

The Examiner's Answer asserts that claim 21 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Appellants respectfully disagree.

At page 4 of the Examiner's Answer, the Answer provides the following basis for the rejection of claim 21:

Claim 21 recites the limitation "wherein the predetermined number of times is predetermined prior to providing the first set of categories of broadcast programs" Applicant's disclosure merely discloses that category maybe added based on number of times a content is selected rather than based on length of time a content is selected [0015], however is silent on the number of times being predetermined prior to providing the first set of categories.

However, the Response to Argument section of the Answer provides a discussion of claim 21 and states that “Appellant’s [sic] disclosure is silent on the *number of times* being greater than 1.” Examiner’s Answer at p. 16. Although this is not the feature on which claim 21 is rejected, Appellants submit that all features of claim 21 are supported by the specification.

As discussed in Appellants Appeal Brief, at least paragraphs [0014] and [0015] describe adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of *times*, wherein the predetermined number of times is greater than 1. It then follows that the predetermined number of times would be determined prior to providing the first set of categories in order to identify the first category of the first set of categories to be added and determine whether the threshold is met. Further, a predetermined number of times implies a plurality of times viewed. Accordingly, Appellants respectfully submit that claim 21 is fully described in the Specification.

III. *Neither Candelore nor Bedard, alone or in combination, teaches or suggests adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcast program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times.*

The Examiner’s Answer asserts, at p. 16-17, that Candelore describes adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*. Appellants respectfully disagree.

The Answer asserts that paragraph [0045] of Candelore describes a system that tracks the number of times a theme was tuned. *See* Examiner’s Answer at p. 17. However, this paragraph, and Candelore in general, merely describes storing *relative statistics* of viewings. There is no teaching or suggestion in Candelore of adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, as recited in independent claims 1 and 7. Rather, Candelore merely describes comparing a number of times a theme is viewed with a number of times another

theme is viewed. No comparison is made between a predetermined number of times and the number of times viewed in Candelore. The addition of Bedard fails to cure this deficiency of Candelore.

As discussed in Appellants Appeal Brief, Bedard describes a method and apparatus for monitoring television viewing activity to determine preferred categories of programming and preferred channels of a viewer. Abstract. Bedard also fails to teach or suggest adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*. The method and apparatus of Bedard include adding a viewed *channel* to a list of preferred channels when the *channel* is viewed for a predetermined *amount of time*. See col. 4, lines 38-40 (emphasis added). At most, Bedard describes adding a category to a viewer profile based on viewing *a channel* associated with that category. See col. 4, lines 49-65 (emphasis added). Bedard fails to teach or suggest adding a category *in response to tuning a device to a broadcasted program fitting into the first category a predetermined number of times*, as recited in claim 1. Instead, Bedard describes adding a channel to the list of channels when the channel is viewed once *for a given period of time*. See col. 5, lines 34-48. A length of viewing time, as described by Bedard, does not constitute a number of times tuned. Further, Bedard describes a system wherein a device may be tuned to a channel more than once but not added to the channel listing because the channel was not viewed for the minimum time required.

For at least these reasons, Appellants submit that independent claims 1 and 7 are patentably distinct from the cited combination of references.

Claims 19 and 21 depend from claim 1 and are allowable for at least the same reasons as their base claims.

IV. None of Candelore, Bedard, and Bronstein, alone or in combination, teaches or suggests removing a second category from the second set upon a selecting of the second category from the second set.

The Examiner's Answer asserts, at p. 18, that "it would have been apparent to one of ordinary skill in the art at the time of the invention to remove favorite items (as taught by Blonstein)

such as a category from the favorites list when the favorites list comprises favorite items such as categories (as taught by Candelore). Appellants respectfully disagree and submit that the Answer is relying on the teachings of the instant application and hindsight reasoning in making this assertion.

Claims 2 and 8 depend from claims 1 and 7, respectively, and are allowable for at least the same reasons as their base claims and further in view of the additional novel and non-obvious features recited therein. The addition of Blonstein fails to cure the deficiencies of Candelore and Bedard with respect to claims 1 and 7. Further, claims 2 and 8 recite, among other features, removing a second *category* from the second set upon a selecting of the second *category* from the second set. None of the cited references, alone or in combination, teaches or suggests the features of claims 2 and 8. At most, Blonstein describes removing a *channel* from a favorites list. *See* col. 12, lines 23-30. However, there is no teaching or suggestion of removing a *category* as recited in claims 2 and 8. Thus, Applicants submit that claims 2 and 8 are allowable for at least this additional reason.

V. None of Candelore, Bedard, or Rothmuller, alone or in combination, teaches or suggests removing a second category from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the second category from the second set.

The Examiner's Answer asserts, at p. 18, that Rothmuller, Candelore and Bedard describe removing a second *category* from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the second category from the second set. Appellants respectfully disagree. In fact, none of the cited references, alone or in combination, teaches or suggests these features. At most Rothmuller describes removing a program *title* from a favorite program list based upon expiration of a predefined time period. There is absolutely no teaching or suggestion of removing any category, let alone a *category* from a set of categories upon a broadcast viewing device *not being tuned* for a period of time at least equal to a first predetermined threshold, to at least one broadcasted *program* predetermined to be in the second category from the second set. In fact, Rothmuller fails to teach or suggest removing any item

based on a viewing device not being tuned to a program. Thus, Appellants submit that the claims are patentably distinct from the cited combination of references.

VI. Claim 13 is patentably distinct from the cited combination of references.

As discussed in Appellants' Appeal Brief, claim 13 recites, among other features, a first unit providing a first set of categories of content of broadcasted programs and a second unit coupled with the first unit and configured to add a category from the first set to a second set of categories of broadcasted programs *in response to selecting the category* from the first set and *tuning a broadcasted program viewing device*, for a period of time at least equal to a first predetermined threshold, *to at least one broadcasted program predetermined to be in the category* from the first set, wherein the second unit further includes a user verification wherein a user approves the category from the first set being added to the second set prior to the category being added. Appellants respectfully submit that none of Candelore, Ellis or Schein, alone or in combination, teaches or suggests the features of claim 13.

Similar to the discussion above, Candelore fails to teach or suggest adding a category from the first set to a second set of categories of broadcasted programs *in response to selecting the category* from the first set and *tuning a broadcasted program viewing device*, for a period of time at least equal to a first predetermined threshold, *to at least one broadcasted program predetermined to be in the category* from the first set, as recited in claim 13. At most, Candelore describes adding a program to a favorites list based on *relative* viewing statistics. See paras. [0045], [0046]. There is absolutely no teaching or suggestion in Candelore of adding a category to a second set and tuning a broadcasted program viewing device for a period at least equal to a first predetermined threshold. As discussed above, adding a program to a favorites list based on relative statistics does not constitute tuning a broadcast program viewing device for a period at least equal to a first predetermined threshold. The addition of Ellis and Schein fails to cure the deficiencies of Candelore with respect to claim 13. Accordingly, Appellants respectfully submit that claim 13 is allowable over the cited combination of references.

CONCLUSION

Appellants believe that the above reasoning presents the clearest arguments for overturning the rejection. For all the foregoing reasons, and based on the previously submitted arguments, Appellants respectfully request that the Board instruct the examining corps to withdraw the rejections and pass this case to issuance at its earliest convenience. If there are any questions or any additional information is required, please contact Appellant's undersigned representative at (202) 824-3174.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Date: December 21, 2010

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